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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/645,231

08/21/2003

Kenneth Scott Thomson

2003P07278US01

7156

7590

03/03/2005

Elsa Keller, Legal Assistant
Intellectual Property Department
SIEMENS CORPORATION
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EXAMINER

TAMAI, KARL I

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

CT

Office Action Summary	Application No. 10/645,231	Applicant(s) THOMSON ET AL.	
	Examiner Tamai IE Karl	Art Unit 2834	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/04; 5/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a connector in a motor, classified in class 310, subclass 71.
- II. Claims 17, drawn to a method of making a connector, classified in class 029, subclass 596.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions Groups I and II are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the apparatus does not require the printed circuit board mounted in the connector structure or molding a plastic material over the circuit board.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Frank Nuzzi (Reg. # 42,944) on 2/28/2005 a provisional election was made without traverse to prosecute the invention of Group I,

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claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claim 17 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

5. The examiner notes that the USPTO 1449 filed June 17, 2004 includes Patent Number 6258915 to Moskob, however the patent number was incorrectly typed. The correct number for the Moskob patent is 6528915. The examiner has crossed out the incorrect patent number and inserted the correct number, inventor, and filing date. The examiner notes the patent 6528915 was also cited USPTO 1449 filed on the May 24, 2004.

Specification

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Information Disclosure Statement

7. The examiner notes that the USPTO 1449 filed June 17, 2004 includes Patent Number 6258915 to Moskob, however the patent number was incorrectly typed. The correct number for the Moskob patent is 6528915. The examiner has crossed out the incorrect patent number and inserted the correct number, inventor, and filing date. The examiner notes the patent 6528915 was also cited USPTO 1449 filed on May 24, 2004.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 3, 8, 9, 10, 11, 13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Moskob (WO 00/38300)(The examiner relies upon Moskob US 6528915 as an English translation). Moskob teaches a motor having a housing with a metal first portion 10 and second portion 17 integral with the metal portion 10 and housing the leads (extending from the bottom of 4 and extend transversely to the PCB). Moscob teaches the brush card assembly/connector body 17 outside the housing 10 and including a recess for the PCT 33. Moskob teaches a brush card assembly 17 having a brushes 15, a printed circuit board (PCB) 33 with EMI suppression capacitors 55, a contact member 37, and control control circuits 4 to pass current to the brushes 15, and provide an AC ground and EMI shield. Moskob teaches a cover 31 over the printed circuit board 33.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskob (WO 00/38300), in further view of Tarnow et al. (Tarnow)(US 3924147).

Moskob teaches every aspect of the invention except the ends of the leads soldered to the PCB. Tarnow teaches the leads 36, 37 soldered to the PCB with solder. It would have been obvious to a person of ordinary skill in the art at the time of the invention to construct the motor of Moskob with the leads soldered to the PCB because Tarnow teaches the leads are soldered to reduce costs and allow easy installation.

13. Claims 5-7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskob (WO 00/38300), in further view of Adams et al. (Adams)(US 4727274).

Moskob teaches every aspect of the invention except the molded cover filling the recess and covering the PCB. Adams teaches that the terminals and interference components

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can be resin covered to fill the recess as an alternative to a cover in order to seal the components. It would have been obvious to a person of ordinary skill in the art at the time of the invention to construct the motor of Moskob with the PCB and capacitors covered with resin to seal the motor as taught by Adams.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl I.E. Tamai whose telephone number is (571) 272 - 2036.

The examiner can be normally contacted on Monday through Friday from 8:00 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg, can be reached at (571) 272 - 2044. The facsimile number for the Group is (703) 872 - 9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karl I Tamai
PRIMARY PATENT EXAMINER
February 28, 2005



KARL TAMAI
PRIMARY EXAMINER

Cited refs: Moskob (WO 00/38300), US 3924147, 4727274, 6528915